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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,723	02/27/2001	Helen Biddiscombe	6001-011	3720

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EXAMINER
BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
1772	11

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

Office Action Summary	Application No.	Applicant(s)	
	09/763,723	BIDDISCOMBE, HELEN	
	Examiner	Art Unit	
	Christopher P Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 12-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 12-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 rejections of claims 8 and 10-11 of record in Paper #5, Page 2, Paragraphs 1-3 have been withdrawn due to Applicant's amendment in paper #8.

2. The obviousness-type double patenting rejections of claims 1-11 of record in Paper #5, pages 5-6, Paragraphs 10-11 have been withdrawn due to Applicant's terminal disclaimer in Paper #9.

REJECTIONS REPEATED

3. The 35 U.S.C. 102 rejections of claims 1-8, and 10 as anticipated by Takagi are repeated for the reasons previously of record in Paper #5, Page 3, Paragraph 5.

4. The 35 U.S.C. 103 rejections of claims 1-10 over Rackovan et al are repeated for reasons previously of record in Paper #5, Page 4, Paragraph 7.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rackovan et al (USPN 5,435,963).

Rackovan et al teaches all that is claimed in claim 9 as discussed previously in paper #5, Page 3, Paragraph 6, but fails to explicitly teach "a shrinkage of at least 4% in both directions. However, for the reasons presented in Paper #5, Page 3, Paragraph 6, it is obvious to one having ordinary skill in the art to have varied the degrees of shrinkage within the

thickness of the label to have balanced the shrinkability and to have minimized curling. Rackovan also teaches the outer layer comprises polypropylene, which is a heat sealable polymer and that the polypropylene homopolymers comprises a titanium dioxide, which is filler that is a pigment (col.7, l.7-18).

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rackovan et al (USPN 5,435,963) in view of Takagi (USPN 5,078,817).

Rackovan et al teach all that is claimed in claim 9 as discussed above, and teach that a heat activatable adhesive or heat-sensitive adhesive is found in at least the base layer. Rackovan et al fail to explicitly teach that the heat-sensitive adhesive contains hydrogenated hydrocarbon or that the heat-sensitive adhesive is also found in the intermediate layer. However, Takagi teaches that heat-sensitive adhesives in heat shrinkage labels are well known to include petroleum or hydrogenated hydrocarbon resins (col.5, l.9-20) and that the use of these adhesives in shrinkage labels enables the shrinking power of the film to occur uniformly so that deformation of the label does not occur (col.5, l.9-20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the heat-

sensitive adhesives in both the base layer and the intermediate layer, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Additionally, it would also have been obvious to add the petroleum or hydrogenated hydrocarbon resin of Takagi as the pressure-sensitive adhesive of Rackovan et al since it has been held that it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments filed in Paper #8 regarding the 35 U.S.C. 112 rejections and double patenting rejections of record have been considered but are moot since the rejections have been withdrawn.

8. Applicant's arguments filed in Paper #8 regarding the 35 U.S.C. 102 rejections of claims 1-8 and 10-11 as anticipated by Takagi have been fully considered but they are not persuasive.

In response to the applicant's argument that Takagi teaches wrap-around labeling and the instant invention teaches in-mold labeling, the method of forming the device is not germane to the

issue of patentability of the device itself. Therefore, this limitation receives little patentable weight. Article claims are defined strictly by structural limitations and not how the articles are formed because more than one process can be used to form the same article. As the instant invention is claimed, Takagi anticipates all of the structural limitations, because with comprising language the structure of the wrap-around label of Takagi is the same as the in-mold label of the instant invention.

9. Applicant's arguments filed in Paper #8 regarding the 35 U.S.C. 103 rejections of claims 1-11 over Rackovan et al have been fully considered but they are not persuasive.

In response to Applicant's arguments that when the label of Rackovan is biaxially stretched, the machine direction stretch is significantly higher than the transverse direction, the limitation that one direction is stretched more than the other does not limit the lowest stretch from still being greater than 6%, which is found to be within the skill of one having ordinary skill in the art to determine. Additionally, Rackovan does teach that there must be a balance between shrinkage and curl, but one of ordinary skill in the art depending on the intended outcome would be able through routine experimentation to vary

the degrees of shrinkage with the thickness of the label to have balanced the shrinkability and to have minimized curling, absent showing unexpected result.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to

Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB
March 24, 2003

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/3/03